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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/535,510

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4662-22

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12/12/2008

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EXAMINER

SACKEY, EBENEZER O

ART UNIT

PAPER NUMBER

1624

MAIL DATE

DELIVERY MODE

12/12/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/535,510

**Applicant(s)**

VERZIJL ET AL.

**Examiner**

EBENEZER SACKEY

**Art Unit**

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF 298)  
Paper No(s)/Mail Date 11/08/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### **Status of the Claims**

Claims 1-10 are pending.

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### ***Information Disclosure Statement***

Receipt of the Information Disclosure Statement filed on 11/02/05 is acknowledged and has been entered into the file. A signed of the 1449 is attached herewith.

**Claim Rejections - 35 U.S.C. § 103**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Gastrock et al.*, (U.S. Patent number 4,683,324) in view of *P. Lopez-Serrano* (cited by applicants), *Kubaneck et al* (U.S. Patent number 3,692,775) and *Myers et al.*

Applicants claim a process for the racemization of an enantiomerically enriched  $\alpha$ -amino nitrile wherein the enriched  $\alpha$ -amino nitrile is contacted with a Lewis acid catalyst in an aprotic solvent.

**Determination of the scope and content of the prior art (MPEP §2141.01)**

Gastrock et al., teach the racemization of  $\alpha$ -amino nitrile in the presence of tartaric acid catalyst. See the entire reference, especially Examples 1 and 2. Note Gastrock teaches resolution as well as racemization process thus, the provisions of claims 6 and 7 are met in view of Lopez-Serrano which teaches that enzyme (lipases) mediated resolution is an attractive option, which further teach that lipases from *Pseudomonas* and *Chromobacterium viscosum* act as catalyst is racemization processes. See the first page.

**Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)**

Gastrock et al., differs from the current invention in that a protic solvent such as methanol is employed in the process. However, Myers et al., teach that the use of aprotic solvent in the racemization of amino nitrile is known and expected to succeed. See the entire reference. Note Myers teaches *in situ* racemization and crystallization on pages 3337 and 3338, the first paragraph, thus the limitations of claims 8-10 are met.

**Finding of prima facie obviousness---rational and motivation (MPEP §2142-2143)**

Accordingly, at the time of filing this application, it would have been *prima facie* obvious to one of ordinary skill in the art to prepare amino nitriles as disclosed by Gastrock et al., guided by the disclosures of Myers et al., and Kubanek et al., with a reasonable expectation that the resulting products would be pure because Myers discloses that the requisite aprotic solvent is known and expected to result in the

preparation of amino nitrile. See page 3338, column 2, lines 3-5. Hence, one in possession of Myers, Kubanek and Lopez-Serrano et al., guided by the disclosure of Gastrock is in possession of the instant process absent a showing of unexpected results or properties. The reaction that is being claimed is a predictable and expected reaction. Thus, the use of aprotic solvent in the instant process per say is uninventive and thus, *prima facie* obvious.

Accordingly, the instantly claimed process would therefore have been suggested to one of ordinary skill in the art.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (571) 272-0704. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson, can be reached on (571) 272-0661. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

EOS

**/JAMES O. WILSON/  
Supervisory Patent Examiner  
Art Unit 1624.**